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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT PAPER NUMBER

1772

DATE MAILED: 01/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/934,031

Applicant(s)

ERICKSEN, MARY A.

Examin r

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication app ars on th cover sh t with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 23-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 15-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I, claims 1 – 14 and 23 – 33 in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 6 – 9, 11 – 14, 26 – 29 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “capable of” in claims 2 and 31 is unclear, which render the claims vague and indefinite. It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The phrases “being subjected” and “after being subjected” in claims 6 – 8, 11 – 13, 26 – 28 and 31 is unclear, which renders the claims vague and indefinite. The action taking place in

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the claim is not positively recited. It seems a conditionally intended use is taking place without reciting what the affects to the beads are if the abrasion had not occurred. The claims also contain process limitations, which are not given patentable weight is a product claim, the action of "subjected".

4. The term "substantially held in place" in claims 9, 14 and 29 is a relative term which render the claims indefinite. The term "substantially held in place" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Correction/clarification is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 – 3, 6 – 8, 10 – 13, 23 – 28 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by May (USPN 4,648,689).

May discloses a tape with an adhesive side (Figure 2, #3 and Column 3, lines 38 – 39)

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and a non-adhesive side (Figure 1, #4) where the adhesive is a pressure sensitive adhesive (Column 5, lines 13 – 18) which sticks to the surface to which it is applied (Column 5, lines 19 – 24). The tape is formed from a closed-cell cross-linked foam material chosen from a variety of materials including polyurethane, silicone rubber, ethylene propylene diene terpolymer or neoprene (Column 3, lines 34 – 37). A layer of reflective microspheres, glass beads with an aluminum coating (Column 3, lines 47 – 49), are attached to the non-adhesive side of the tape by embedding the spheres in the surface of a polymeric sheet (Column 3, lines 44 – 47). Since May discloses glass beads with a coating of aluminum reflective material on their embedded surfaces secured on the non-adhesive side of the tape (Column 3, lines 47 – 49), it is inherent that the reflective brightness of the beads would be greater than 70 or 90% after 750 or 5,000 cycles.

Regarding the limitation of the retroreflective beads being melted or laminated into the non-adhesive side of the tape, in claims 1, 3, 10, 23 and 25 and the limitations of coating, covering and applying heat and pressure in claim 24, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of melting, laminating, coating, covering and applying heat and pressure are methods of production and therefore do not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which

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reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 5 and 31 – 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over May in view of Carte et al. (USPN 5,947,917).

May discloses a tape with an adhesive side (Figure 2, #3 and Column 3, lines 38 – 39) and a non-adhesive side (Figure 1, #4) where the adhesive is a pressure sensitive adhesive (Column 5, lines 13 – 18) which sticks to the surface to which it is applied (Column 5, lines 19 – 24). The tape is formed from a closed-cell cross-linked foam material chosen from a variety of materials including polyurethane, silicone rubber, ethylene propylene diene terpolymer or neoprene (Column 3, lines 34 – 37). A layer of reflective microspheres, glass beads with an aluminum coating (Column 3, lines 47 – 49), are attached to the non-adhesive side of the tape by embedding the spheres in the surface of a polymeric sheet (Column 3, lines 44 – 47). Since May

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discloses glass beads with a coating of aluminum reflective material on their embedded surfaces secured on the non-adhesive side of the tape (Column 3, lines 47 – 49), it is inherent that the reflective brightness of the beads would be greater than 70 or 90% after 750 or 5,000 cycles. However, May fails to disclose the tape being a medical tape with a foam or non-woven backing material.

Carte et al. teaches a foam (Column 2, lines 64 – 67) or non-woven backing material (Column 3, lines 44 – 52) in a medical tape (Column 3, lines 31 – 34) with a pressure sensitive adhesive coated on one of the sides of the backing material (Column 3, lines 25 – 28 and Column 5, lines 33 – 41) for the purpose of easy removal of the tape from the skin of the user so that the skin is not irritated.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the medical tape formed with either foam non-woven backing material with a pressure sensitive adhesive in May in order to easily remove the tape from the skin of the user so that the skin is not irritated.

Regarding the limitation of the retroreflective beads being laminated into the non-adhesive side of the tape, in claim 31, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227

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USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of laminating is a method of production and therefore does not determine the patentability of the product itself.

Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

9. Claims 9, 14 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over May in view of Crandall et al. (USPN 5,747,827).

May discloses the claimed tape above except for the retroreflective beads being substantially held in place on the first side of the foam backing without the use of an adhesive or a resin.

Crandall et al. teaches a reflective metal coating (Figure 1, #122) on top of a binder layer (Figure 1, #110) where microspheres are embedded into the metal coating to adhere them to the surface (Figure 1, #121) in a sheet material for the purpose of attaching the spheres to the surface of the article to reflect light.

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It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided to use the metal coating to attach the spheres to the surface of the tape or article in May in order to reflect light from the surface of the article.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-5480. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

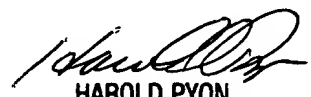
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer
Examiner
Art Unit 1772

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pln

January 9, 2003


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

1/10/03